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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772

7590  
OBER / KALER  
c/o Royal W. Craig  
120 East Baltimore Street  
Baltimore, MD 21202

EXAMINER
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FIGUEROA, ADRIANA

ART UNIT	PAPER NUMBER
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3633

MAIL DATE	DELIVERY MODE
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12/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,836	<b>Applicant(s)</b> HORTON, WADE C.	
	<b>Examiner</b> Adriana Figueroa	<b>Art Unit</b> 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-11,13,14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2008 has been entered.

### ***Claim Objections***

2. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation "a recessed light fixture" was already introduced on claim 1.

### ***Claim Rejections - 35 USC § 112***

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "said article" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6, 7, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239).

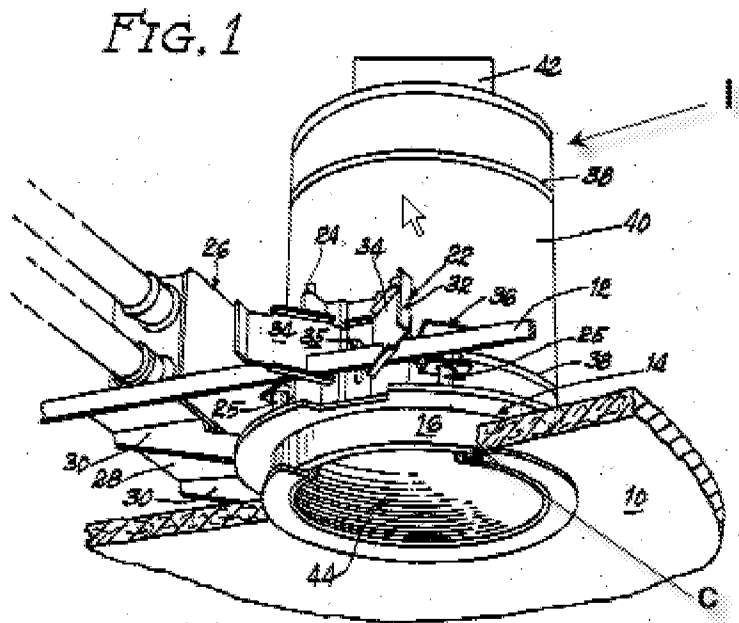
Regarding claim 1, Bobrick discloses in combination with a ceiling (10) comprising a planar surface defined by opposing sides and having cutout (c) there through, a recessed lighting fixture (l) mounted on one side of said planar surface over said cutout and conforming thereto, (annotated Fig 1), and a finishing ring (46) defined by an aperture conforming to said cutout, mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture (l) for providing a transition from said planar surface to said recessed lighting fixture, (Fig 1, Fig 5), but does not disclose an accent frame comprising a rigid thin sheet of material said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than a finishing ring, and a convex inner edge defining an aperture conforming to a cutout, and having an annular lip circumscribing said aperture for proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in place there between by the pressure of said finishing ring being retained to said recessed lighting fixture; the flat two-dimensional object-shaped outer edge of said accent frame protrudes beyond said finishing ring and serves

Art Unit: 3633

as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

However, Hill teaches an accent frame(10) comprising a rigid thin sheet of material said rigid thin sheet having an outer edge (e) defining a flat two-dimensional object-shape larger in diameter than a finishing ring (5), and a convex inner edge (c) defining an aperture conforming to a cutout, and having an annular lip (l) circumscribing said aperture for proper positioning with said cutout, (annotated Fig 1, Fig 2), said accent frame (10) being sandwiched between said finishing ring (5) and a planar surface and maintained in place there between by the pressure of said finishing ring being retained to the switch plate, (Fig 4); the flat two-dimensional object-shaped outer edge (e) of said accent frame (10) protrudes beyond said finishing ring (5) and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (Fig 1, 2, 4).

Examiner would like to point out that the convex inner edge and the annular lip of Hill are considered to have the same structure of the convex inner edge and the annular lip of the instant application. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the lighting fixture assembly of Bobrick to include an accent frame as taught by Hill in order to provide an ornamental appearance and to enhance the general appearance of the lighting fixture assembly.



Regarding claim 2, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) having a decorative outer edge.(e), (annotated Fig 1, 2).

Regarding claim 3, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) being seated flush with said planar surface (p), (annotated Fig 4).

Regarding claim 4, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) flares slightly away from the planar surface (p) to provide an aesthetically pleasing depth or texture to the frame, (annotated Fig 4).

Regarding claim 6, Bobrick modified by Hill discloses as discussed above, but does not specifically teaches said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere

Art Unit: 3633

change in the size of the component and would provide a light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 7, Bobrick modified by Hill discloses as discussed in claim 1 including the recessed lighting fixture (I), (annotated Fig 1).

Regarding claim 9, Bobrick modified by Hill discloses as discussed in claim 1 Bobrick further teaches the planar surface being a ceiling (10), (Fig 1).

Regarding claim 10, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

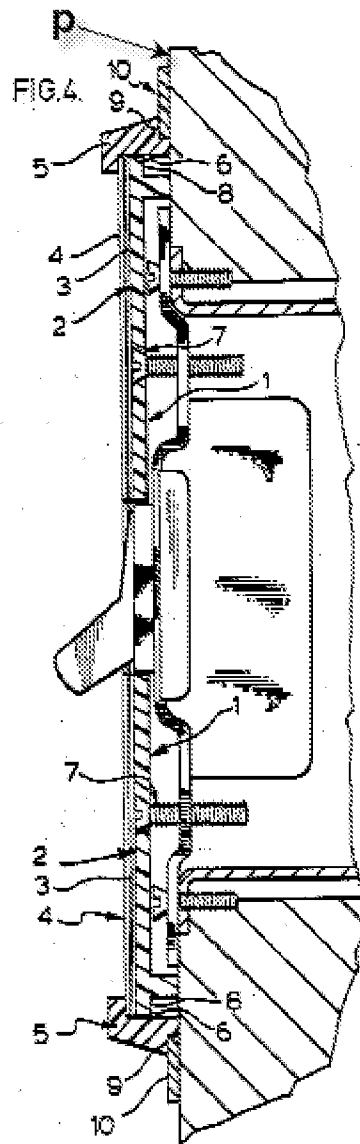
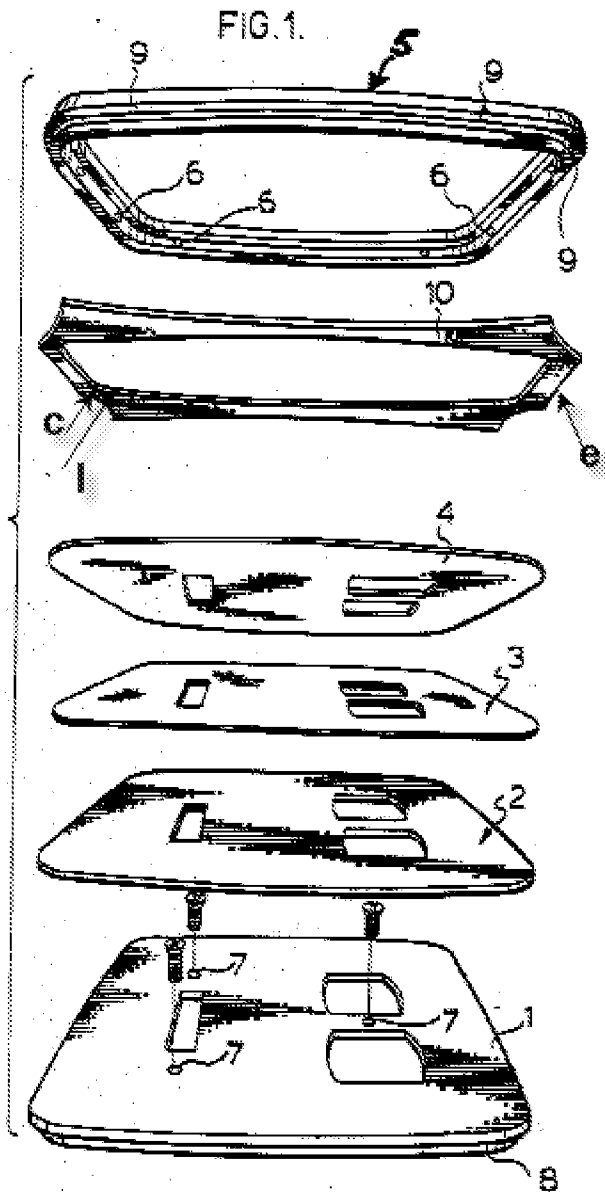
Regarding claim 13, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Bobrick and Hill to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the

Art Unit: 3633

shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).





5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Gretz (US 6,152,413). Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's

Art Unit: 3633

invention to modify the frame of Bobrick and Hill to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adriana Figueroa whose telephone number is 571-272-8281. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. F./  
Examiner, Art Unit 3633  
12/5/2008

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633